

Remarks

The present Amendment is submitted in response to the Office Action dated August 29, 2008, which set a three-month period for response.

Reconsideration and allowance of the application in view of the amendments above and the following remarks is respectfully requested.

In the Office Action, claims 1-4 are rejected under 35 USC §103(a) as unpatentable over US Patent No. 6,168,625 to Prescott (Prescott) in view of US Patent Application Publication No. 2005/0165481 to Steinhardt, et al. (Steinhardt) and further in view of US Patent Application Publication No. 2007/0048708 to Lee (Lee). Claim 5 is rejected under 35 USC §103(a) as unpatentable over Prescott, Steinhardt and Lee, and further in view of US Patent Application Publication No. 2005/0267600 to Haberman, et al. (Haberman). Claims 6-8 are rejected under 35 USC §103(a) as unpatentable over Prescott and Steinhardt and further in view of Lee. Claim 5 is rejected under 35 USC §103(a) as unpatentable over Prescott, Steinhardt and Lee, and further in view of US Patent Application Publication No. 2004/0148025 to Schneider, et al. (Schneider). Claim 10 is rejected under 35 USC §103(a) as unpatentable over Prescott, Steinhardt and Lee, and further in view of US Patent Application Publication No. 2005/0107869 to Sirhan, et al. (Sirhan). Claims 11-19 are rejected under 35 USC §103(a) as unpatentable over Prescott and Steinhardt and further in view of Lee.

In response to the objection to the Abstract, applicants have amended the Abstract as shown above. Applicants believe that the Abstract now complies with MPEP §608.01(b) and, therefore, respectfully request withdrawal of the objection to the Abstract.

In response to the objection to the drawings for failure to expressly show “additional mass” (claims 18 and 19), and “clip” (claim 19), claims 18 and 19 are cancelled without prejudice or disclaimer of subject matter. As such, the drawings now comply with 37 CFR 1.83(a), and applicants respectfully request withdrawal of the objection to the drawings.

In response to the objection to the Specification (disclosure) for use of the term “modulo”, applicants have amended the specification as shown in the paragraph above to replace “modulo” with -- modulus --. Accordingly, applicants respectfully request withdrawal of the objection to the Specification (disclosure).

In response to the objection to Claim 1 for use of the term “modulo”, applicants have amended claim 1 as shown above to replace “modulo” with -- modulus --. Accordingly, applicants respectfully request withdrawal of the objection to claim 1.

In response to the rejection of claims 18 and 19 under 35 USC §112, first paragraph, applicants have cancelled claims 18 and 19 without prejudice or disclaimer of subject matter. Applicants, therefore, respectfully request withdrawal of the rejection.

In response to the rejection of claims 3, 12, 14-16 and 20 under 35 USC §112, second paragraph, as indefinite, applicants have amended claims 3, 12 and 15 substantially in accordance with the Examiner's suggestions, and cancelled claims 14, 16-20 without prejudice or disclaimer of subject matter. For example, claim 3 is amended to recite "at least one recess" and claim 21 is added to recite a plurality of recesses, claim 9 is amended and new claim 22 added based on claim 9, and claims 12 and 15 are amended to Markush form. Applicants, therefore, respectfully request withdrawal of the rejection of claims 3 and 15 under 35 USC §112, second paragraph.

Each of the claims have been amended to replace the phrase "characterized in that" with -- wherein --, and for formal matters where necessary. After amendment, claims 1-13, 15, 21 and 22 are pending, where claim 1 is the sole independent claim.

Turning now to the substantive rejection of the claims, applicant respectfully submits that claims 1-13, 15 and new claims 21 and 22 are patentable over Prescott, Steinhardt and Lee, whether the combination is taken alone or further in combination with any combination of Haberman, Schneider or Sirhan, for at least the following reasons.

After amendment, independent claim 1 call outs an ossicle prosthesis (10; 20), which replaces or spans at least one member of a human ossicle chain, in which the ossicle prosthesis (10; 20) includes a first securing element (11) on one end and a second securing element (12; 22) on its other end, the second

securing element adapted for mechanical connection to a member of the ossicle chain, to the eardrum or to the inner ear,

wherein between the two securing elements (11, 12; 22) is a ball joint, which includes two struts (13, 13') that are solidly joined to the first securing element (11), and extend parallel or at an angle to one another enclosing a gaplike space in which a ball (14) is pivotably supported in two recesses (15) in the struts (13, 13'), and which ball (14) is part of an elongated shaft (16) that connects the two securing elements (11, 12; 22) to one another,

wherein the elongated shaft (16) further includes many balls (14, 14', 14'') adjoining one another, of which one is the ball (14) in the ball joint, and is displaceable through the gaplike space between the two struts (13, 13') of the ball joint, in a direction perpendicular to the struts (13, 13') extending towards or away from the first securing element (11), through a perforation (17) in the first securing element (11),

wherein one each of the balls (14, 14', 14'') snaps in a snapped-in position between the recesses (15) of the struts (13, 13'), so that a desired length of the shaft (16) modulus adjusts the spacing of the balls (14, 14', 14'') from one another, and the part of the shaft (16) protruding through and past the first securing element (11) can be cut to length; and

wherein the gaplike space between the two struts (13, 13') of the ball joint can be made narrower for fixation of the shaft (16) after the desired length has been adjusted.

Prescott, as distinguished, discloses an adjustable length prosthesis for ossicular replacement or reconstruction that comprises a shaft. As described at the full paragraph on page 3 of applicants' Specification, Prescott's shaft has many notches along its axis that are meant to serve as rated breaking points for cutting the shaft to length later during the operation. The thus-created wavy shaft is intended to produce increased friction within a receiving part. But as stated, however, postoperative automatic compensation for hydrostatic forces engaging the eardrum cannot be implemented with the Prescott invention. Prescott's receiving part, together with the portion surrounded by it of the wavy shaft, does not form a ball joint. That is, there is no spherically-shaped ball or ball joint disclosed by Prescott (or any other of prior art), and hence there are many geometric and functional differences between the claim 1 ossicle prosthesis (10) and Prescott.

Moreover, while the Examiner rejects independent claim 1 under Section 103(a) over Prescott in view of Steinhardt and further in view of Lee, Steinhardt falls under the Section 103(c) exception in view of its common ownership, and Lee is not prior art. Hence, and with all due respect, the Examiner has failed to establish a *prima facie* case of obviousness under 35 USC §103(a) by Prescott in view of Steinhardt and further in view of Lee.

In more detail, applicants respectfully submit that Steinhardt is available as prior art with regard to the present application only under 35 U.S.C. §102(e), and is not available as prior art under §103(a) for the following reasons.

The present application was filed in the United States on May 16, 2006, based on a foreign priority date of March 9, 2005, and thus has the benefit of the November 29, 1999, changes to 35 U.S.C. §103(c). Under 35 U.S.C. §103(c), "Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person" (emphasis added).

The subject matter of Steinhardt and the claimed invention are and were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s), i.e., Heinz Kurz GMBH Medizintechnik. The foreign priority date for the present application is March 9, 2005. Steinhardt is not a proper reference under section 103(a) even in view of the fact that Steinhardt has a foreign filing date of January 23, 2004, prior to the March 9, 2005, priority date of this application. The reason for same is because Steinhardt is assigned to Heinz Kurz GMBH Medizintechnik, and was not published/issued prior to the foreign priority date of the present application, i.e., March 9, 2005.

Thus, 35 U.S.C. § 103(c) is available to withdraw Steinhardt as a reference with regard to the rejection of claims 1-4 under 35 U.S.C. §103(a) over Prescott in view of Steinhardt and further in view of Lee, of claim 5 under 35 USC

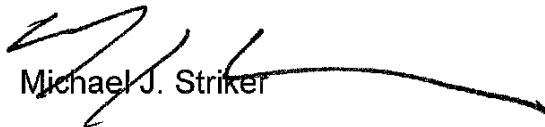
§103(a) over Prescott, Steinhardt, Lee and further in view of US Haberman, claims 6-8 under 35 USC §103(a) over Prescott, Steinhardt and further in view of Lee, claim 5 under 35 USC §103(a) over Prescott, Steinhardt, Lee and further in view of Schneider, claim 10 under 35 USC §103(a) over Prescott, Steinhardt, Lee and further in view of Sirhan and claims 11-19 under 35 USC §103(a) over Prescott, Steinhardt and further in view of Lee.

Furthermore, Lee was filed on August 16, 2006, and Haberman was filed on May 27, 2005, so neither Lee nor Haberman are prior art to the instant application. And while Sirhan may be section 102(e) prior art, the addition of the teaching of Sirhan to the combination of Prescott, Steinhardt and Lee does not overcome the shortcomings of Prescott, or the fact that Steinhardt and Lee are not Section 103(a) art, or proper prior art, respectively, as set forth above.

Applicants, therefore, respectfully request withdrawal of the rejection of rejection of claims 1-4 under 35 U.S.C. §103(a) over Prescott in view of Steinhardt and further in view of Lee, of claim 5 under 35 USC §103(a) over Prescott, Steinhardt, Lee and further in view of US Haberman, claims 6-8 under 35 USC §103(a) over Prescott, Steinhardt and further in view of Lee, claim 5 under 35 USC §103(a) over Prescott, Steinhardt, Lee and further in view of Schneider, claim 10 under 35 USC §103(a) over Prescott, Steinhardt, Lee and further in view of Sirhan and claims 11-19 under 35 USC §103(a) over Prescott, Steinhardt and further in view of Lee.

Accordingly, the application as amended is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application in condition for allowance.

Respectfully submitted,



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